



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re:	Canich	Before Ex.:	Roberto Rabago
Appl No.:	07/676,690	Art Unit:	1713
Filed:	March 28, 1991	Docket No:	89B010A/2
For:	Olefin Polymerization Catalysts	Confirmation No:	7543

Mail Stop: Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. § 1.182

Dear Sir:

This is a Petition under 37 C.F.R. § 1.182 requesting relief in a situation not otherwise provided for. More specifically, Applicant respectfully requests confirmation that the Terminal Disclaimer filed July 27, 1992, was not entered or, in the alternative, withdrawal of the Terminal Disclaimer filed July 27, 1992 in light of the following remarks. Expedited consideration of this Petition is requested, in view of the fact that the issue fee is due to be paid by December 13, 2006.

11/16/2006 JADD01 00000857 07676690

01 FC:1462

400.00 OP

BACKGROUND

Claims 34, 37, 38, and 40-44 have been allowed as indicated in the Notice of Allowability mailed September 13, 2006.

In this regard, Applicant submitted, in a Response filed July 27, 1992, a traversal in response to a double patenting rejection of claims 18-33 over U.S. Patent No. 5,026,798 ("the '798 patent), which was **the only rejection made** in an April 27, 1992, Office Action. In the traversal to the double patenting rejection, Applicant explained why the subject matter of the '798 patent was patentably distinct from the subject matter of this application. Additionally, "for purposes of expediting prosecution (emphasis added), Applicant [attached] a terminal disclaimer over the '798 patent...[and should] the Examiner favorably consider applicant's [remarks], applicant [requested] that the submitted disclaimer not be entered" (see Applicant's July 27, 1992, Response).

REQUEST FOR WITHDRAWAL OF TERMINAL DISCLAIMER

For reasons specified in more detail below, as well as those submitted in a concurrently filed Response Under 37 C.F.R. 1.312, withdrawal of the terminal disclaimer filed on July 27, 1992 is requested.

Applicant can find no acknowledgment whether Applicant's remarks in the July 27, 1992, Response were or were not favorably considered, and whether the submitted disclaimer was or was not considered necessary by the Examiner to overcome the rejection.

Applicant requests confirmation that Applicant's remarks in the July 24, 1992, Response were favorably considered, and that the submitted disclaimer was not required.

While the face of the file seems to indicate that the terminal disclaimer was recorded by the clerical staff, in view of the unexpectedly long delay in Applicant's obtaining a patent for the invention, in conjunction with the reasons discussed below, Applicant requests withdrawal of the disclaimer since the currently allowed claims in the present application would not be subject to a double patenting rejection over the claims of U.S. Patent No. 5,026,798.

In particular, the current claims in this application are directed to a process to polymerize alpha olefins utilizing an unbridged Mono-Cp Catalyst. [Claims 18-33 at the time of the double patenting rejection in this application were directed to a process to polymerize olefins using a bridged or unbridged Mono-Cp catalyst.]

Claims 18-33 were rejected under obvious-type double patenting over claims 1-13 of the '798 patent. Claims 1-13 of the '798 patent are directed to a process to produce crystalline poly-alpha-olefins by contacting monomers with a bridged Mono-Cp catalyst.

Applicant respectfully submits that there is clearly patentably distinct difference between the bridged and unbridged compounds.

In view of the fact that the provisional submission of the Terminal Disclaimer as suggested by the Examiner in the April 27, 1992, Office Action appeared to place the application in condition for allowance, Applicant fully expected that, if Applicant's above-discussed remarks in the July 27, 1992 Response, were not favorably considered, submission of the Terminal Disclaimer would expedite prosecution and Applicant had no reasonable expectation that over fourteen years later a patent would still not yet be finally granted, and would therefore only be limited to a few years of patent term (since no patent term adjustment applies because of the filing date being prior to June 8, 1995).


Thus, Applicant's proffer to expedite allowance of the application at a time when Gatt had not taken effect and the term of the patent would have run 17 years from the date of the issuance of the patent, had the completely unexpected and unforeseeable consequence of eliminating more than 14 years of the 17 year term of any patent issuing from the present application, if the Terminal Disclaimer filed on July 27, 1992 were to be part of the application record.

The double patenting rejection of the claims originally rejected by the Examiner was improper. Applicant traversed that rejection and provisionally proffered a terminal disclaimer simply to expedite issuance of the patent. PTO delays in having the patent issue have effectively delayed issuance of the patent by at least 10 years. The claims that are finally allowed in the Notice of Allowability of September 13, 2006, are not the same as the ones that were subject to a double patenting rejection in April 1992. Furthermore, the currently allowed claims could not be properly rejected over the claims of U.S. patent 5,026,798. Justice requires that the PTO grant relief in this case by way of acknowledging non-entry of the Terminal Disclaimer filed on July 27, 1992 or, in the alternative, permitting withdrawal of the Terminal Disclaimer filed on July 27, 1992 so as to effectuate issuance of the patent with a full 17 year statutory term.

Payment of the \$400 fee required under 37 C.F.R. §1.17(f) is attached. Please charge any additional fees necessary for consideration of the papers filed herein on an expedited basis and refund excess payments to Deposit Account No. 50-2929.

Should the Deciding Official have any questions regarding this matter, Applicant requests that the Examiner telephone the undersigned to discuss any such issues.

Respectfully submitted,



Abraham HersHKovitz
Reg. No. 45,294

November 15, 2006
HERSHKOVITZ & ASSOCIATES
2845 DUKE STREET
ALEXANDRIA, VA 22314

703-370-4800 (voice)
703-370-4809 (fax)

patent@hershkovitz.net

Robert K. Carpenter
Reg. No. 34,794